

REMARKS

This responds to the Office Action mailed on January 22, 2008.

No claims are amended, canceled, or added; as a result, claims 1-3 and 5-33 are now pending in this application.

35 USC §103 Rejection of the Claims

Claims 1-3, 5-6, and 8-33 were rejected under 35 USC § 103(a) as being unpatentable over *Gu* (U.S. Publication No. 2004/0260800) in view of *Oakano* (U.S. Publication No. 2002/0062485).

To support an obviousness rejection, the Examiner must show that “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a) [emphasis added]. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that ‘[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396; MPEP 2141. In

determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). MPEP 2141.02 (I) “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With regard to independent claim 1, in the final office action, the Examiner fails to properly ascertain the differences between the prior art and the claimed invention as required by Graham. In addition, the Examiner fails to provide any articulated reasoning as to why the subject matter as a whole would have been obvious at the time the invention was made in light of the differences between the prior art and the claimed invention. Furthermore, the Examiner does not consider all of the words of the claim in judging the patentability of the claim. For example, as stated in the previous response, independent claim 1 of the present application recites “a tinyDHCP unit to sense said DHCP discover message and allocate an IP address for the client device in response thereto.” Claim 1 indicates that the tinyDHCP unit is within the same client device as the DHCP client that sends the DHCP discover message. The claimed tinyDHCP senses, from within the client device itself, the DHCP discover message sent by the DHCP client and allocates an IP address in response thereto. It thus appears to the DHCP client that it is dealing with an actual DHCP server in the network and not functionality within the same client device. This is neither taught nor suggested by the combination of Gu and Oakano. Gu discloses a device that is capable of developing its own IP address when there is no DHCP server available in a corresponding network, but the device does not include functionality that allows a DHCP client within the device to operate as if a DHCP server were available external to the client device. That is, Gu discusses the AutoIP protocol of Universal Plug and Play (UPnP) that allows a device to claim an IP address from a predetermined range (see paragraph [0532]). Okano was only cited to show that it was well known to allocate an IP address to a client device from a DHCP server that is separate from the client device. Neither of these references teach or suggest the use of a tinyDHCP unit within a client device that senses a DHCP discover message

sent by a DHCP client within the same client device and allocates an IP address to the client device in response to the DHCP discover message.

Even though the above-described differences between the claimed subject matter and the cited references were brought to the Examiners attention in the previous office action response, the Examiner has failed to address these differences in the final action. In the “Response to Arguments” section of the final action, the Examiner discusses the AutoIP protocol of UPnP that is described in Gu, but does not address the fact that the device of claim 1 includes a tiny DHCP that detects a DHCP discover message sent by a DHCP client within the same device and allocates an IP address in response thereto. As described above, the autoIP feature of UPnP, as described in Gu, allows a device to claim an IP address from a predetermined range. But Gu does not teach or suggest a DHCP unit within a client device that sends a DHCP discovery message and a tinyDHCP within the same device that senses the DHCP discovery message and allocates an IP address to the client device in response thereto. The Examiner has not presented any arguments as to why the claimed client device would have been obvious to a person of ordinary skill in the art in light of the indicated differences. The Examiner has stated in the final office action that “It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gu’s invention by utilizing the DHCP system for allocating an IP address to the client device in response to receiving a DHCP discover message whereas dynamic allocation is the only method which provides dynamic re-use of IP addresses. This rationale does not address the clear differences between the claimed subject matter and the cited references and does not rise to the level of “articulated reasoning” envisioned by the Supreme Court in *KSR*.

It is submitted that a person of ordinary skill in the art, knowing about the autoIP feature of UPnP as described in Gu and the fact that remote DHCP servers return IP addresses when they receive DHCP discover messages as described in Okano, would not find it obvious to implement a tinyDHCP unit within a client device that is able to (a) sense when a DHCP client within the same device transmits a DHCP discover message and (b) allocate an IP address to the device in response thereto.

Based on the foregoing, it is submitted that independent claim 1 is not rendered obvious by the combination of Gu and Oakano. Reconsideration and allowance of claim 1 is therefore

respectfully requested. Independent claim 30 should be allowable for at least the same reasons as independent claim 1.

With regard to independent claim 14, the Examiner similarly fails to properly ascertain the differences between the prior art and the claimed invention as required by Graham. In addition, the Examiner fails to provide any articulated reasoning as to why the subject matter as a whole would have been obvious at the time the invention was made in light of the differences between the prior art and the claimed invention. Furthermore, the Examiner does not consider all of the words of the claim in judging the patentability of the claim. For example, claim 14 recites (a) “sending a DHCP discover message from within the client device;” (b) “receiving said DHCP discover message within the client device;” and (c) “allocating an IP address to the client device in response to receiving said DHCP discover message, within the client device.” As with claim 1, these actions are all taking place within the client device. The DHCP discover message is both sent and received within the client device and the IP address is allocated within the client device. This is not disclosed or suggested by the cited references (either alone or in combination).

In the final office action the Examiner identifies the “Discover Listener” signal of Fig. 29 as the claimed “DHCP discover message” that is “sent,” but the Examiner identifies the “Response to Discover” signal of Fig. 29 as the “DHCP discover message” that is “received.” The Applicants respectfully disagree with this analysis. The Examiner identifies two separate signals in Gu to represent a single message in claim 14. That is, the claimed method sends a DHCP discover message from within the client device and also receives the same message within the client device. The client device 950 of Gu transmits a “Discover Listener” signal but receives a “Response to Discover” signal, which is a different signal. Likewise, neither of the references cited by the Examiner disclose or suggest “allocating an IP address to the client device in response to receiving said DHCP discover message, within the client device.”

Based on the foregoing, it is submitted that independent claim 14 is not rendered obvious by the combination of Gu and Oakano. Reconsideration and allowance of claim 14 is therefore respectfully requested. Independent claim 26 should be allowable for at least the same reasons as independent claim 14.

Claims 2-3, 5-6, and 8-13, claims 15-25, claims 27-29, and claims 31-33 are dependent claims that depend either directly or indirectly from independent claims 1, 14, 26, and 30, respectively. Consequently, these claims are allowable for at least the same reasons as their corresponding base claims. These claims also provide further bases for patentability. All arguments presented in the previous response with respect to these claims are maintained in the present response.

Claim 7 was rejected under 35 USC § 103(a) as being unpatentable over *Gu* (U.S. Publication No. 2004/0260800) in view of *Oakano* (U.S. Publication No. 2002/0062485), further in view of *Gardiner* (U.S. Publication No. 2003/0225864).

Claim 7 s is a dependent claim that depends indirectly from independent claim 1. Consequently, this claim is allowable for at least the same reasons as independent claim 1.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (480-948-3745) to facilitate prosecution of this application.

Respectfully submitted,

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By his Representatives,

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480-948-3745

Date March 21, 2008

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of March, 2008.

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